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OFFICE OF PETITIONS

In re Patent No. 7,476,665 :
Burgey et al. : DECISION DISMISSING
Application No. 10/562,297 : REQUEST FOR
Issue Date: January 13, 2009 : RECONSIDERATION OF
Filed: December 22, 2005 : PATENT TERM ADJUSTMENT
Attorney Docket No. 21382YP : UNDER 37 CFR 1.705

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705(d), filed on January 29, 2009. Patentee requests that the determination of patent term adjustment be corrected from two hundred thirty-four (234) days to two hundred fifty-six (256) days.

The request for reconsideration of patent term adjustment is DISMISSED with respect to making any change in the patent term adjustment determination under 35 U.S.C. § 154(b) of 234 days.

BACKGROUND

On September 2, 2008, the Office mailed a notice that the initial determination of patent term adjustment under 35 U.S.C. 154(b) to date is 236 days. On January 13, 2009, the application matured into U.S. Patent No. 7,476,665, with a revised patent term adjustment of 234 days. The Office determined that the 17 days of Office delay pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b) overlaps with the 284 days of Office delay pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1) accorded prior to the issuance of the patent. As such, the Office allowed only entry of the adjustment of 284 days. No additional days of patent term adjustment were entered at issuance under the three-year pendency provision. Given the

applicant delay of 50 days, the patent issued with a revised patent term adjustment of 234 (284 - 50) days.

On January 29, 2009, patentee timely submitted this request for reconsideration of patent term adjustment (with required fee), asserting that the correct number of days of Patent Term Adjustment is 256 days under the courts interpretation of the overlap provision as set forth in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentee asserts entitlement to an additional 22 day period of adjustment, under 35 U.S.C. § 154(b)(1)(B). Patentee avers that section 154(b)(1)(B) provides that applicants are entitled to a term adjustment "if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States." As such, patentee maintains that the total non-overlapping PTO delay under §154(b)(1)(A) & (B) is 306 (284 + 22) days as these periods do not occur on the same day. Further, given the applicant delay of 50 days, patentee asserts entitlement to 256 (306 - 50) days of patent term adjustment.

OPINION

At the outset, the Office notes that patentee's assertion that the period of delay, pursuant to 37 CFR 1.702(b), for the Office taking in excess of three years to issue the patent, is 22 days is incorrect. A review of the record indicates that the date the national stage commenced is December 27, 2005.¹ As stated in 37 CFR 1.703(b), the period of adjustment under § 1.702(b) is the number of days in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued. While the date of completion of all 35 U.S.C. 371 requirements, December 22, 2005, is the date used in calculation of the examination delay under 37 CFR 1.702(a)(1), the date the national stage commenced under 35 U.S.C. 371(b), December 27, 2005, is used to determine the Three Year Delay under 37 CFR 1.703(b).

Pursuant to 37 CFR 1.703(b), the period of adjustment under 37 CFR 1.702(b) should be 17 days, counting the number of days

¹ Monday, December 26, 2005 was a U.S. federal holiday.

beginning on the day after the date that is three years after the date on which the national stage commenced under 35 U.S.C. 371(b), December 27, 2005, and ending on the date the patent issued, January 13, 2009.

Furthermore, patentee's interpretation of the period of overlap has been considered, but found inconsistent with the Office's interpretation of the overlap provision, 35 U.S.C. 154(b)(2)(A). 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final*

Rule, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

Further, as stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C.

154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding §1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the period during which the application was pending before the Office beginning on the commencement date, December 27, 2005, and ending on the date of the issuance of the application as a patent, January 13, 2009, (not including any other periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)).

Pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1), 284 days of patent term adjustment were accorded during the pendency of the application for Office delay prior to the issuance of the patent. Pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b), 17 days of patent term adjustment accrued for Office issuance of the patent more than 3 years after the commencement date.

The 17 days of patent term adjustment under 37 CFR 1.702(b) overlap with the 284 days of patent term adjustment under 37 CFR 1.702(a)(1). Entry of both the 17 days and the 284 days is

neither permitted nor warranted. 284 days is the actual number of days issuance of the patent was delayed. Considering the applicant delay of 50 days, the patent term adjustment at issuance is 234 (284 - 50) days.

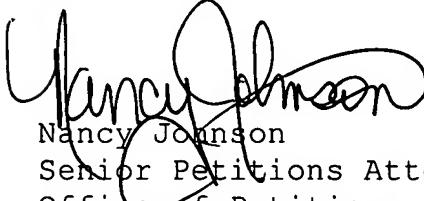
Accordingly, at issuance, the Office properly entered 0 additional days of patent term adjustment for the Office taking in excess of three years to issue the patent.

CONCLUSION

In view thereof, no adjustment to the patent term will be made.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Telephone inquiries specific to this matter should be directed to Senior Petitions Attorney Douglas I. Wood, at (571) 272-3231.



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Office of Petitions